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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,530	07/27/2001	Cyril Hue	Q64889	9543

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EXAMINER

KHAN, ASHFAQ M

ART UNIT PAPER NUMBER

2137

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/915,530	Applicant(s) HUE ET AL. S	
	Examiner Ashfaq Khan	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07-27-2001</u> . | 6) <input type="checkbox"/> Other: ____. |

Remarks

Claims 1-9 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-4 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Lemilainen et al (US 6766160).

1) Regarding claim 1 Lemilainen discloses, a method for performing a short-range wireless transaction between an hybrid (Item# 12 of FIG1, Col 5 line 14-18, Col 2 line 54-56) wireless terminal and a service terminal (Item# 26 of FIG 1, Col 7 line 40-49) said hybrid terminal being able to communicate over a first interface with a radio communication network (Col 3 line 11-13) and over a second interface for short-range wireless (Col 2 line 46-50, Col 1 line 10-13, Col 3 line 32-37) access with said service terminal, said hybrid wireless terminal comprising a user authentication information (Item# 22 of Fig 1, Col 2 line 46-56) for authenticating a user in said radio

communication network, said method being characterized in that it comprises the steps of:

- transmitting over said second interface a message to said service terminal comprising said user authentication information; (Item# 22 of Fig 1, Col 2 line 46-56, Col 5 line 19 – 21 and Col 3 line 32-37)
- authenticating said user at said service terminal by checking said received user authentication information against an authentication database; (Item 54 and 38 of Fig 1 and Col 3 line 32-37. Note: Item 38 stores a subset of the information stored in Item 54)
- enabling said transaction if said user authentication has been successful. (Col 6 line 24–33)

2) As per claim 2 Lemilainen discloses that the method according to claim 1, characterized is that said authentication database (Item 38 of Fig 1) is shared by said service terminal (Item 26 of Fig 1) and said radio communication network (Network connecting Item# 32 with the Item# 38 of Fig 1. Note: The Network is depicted in Fig 1).

3) As per claim 3 Lemilainen teaches that the method according to claim 2, characterized in that said authentication database is the Home Location Register of said radio communication network. (Col 5 line 42 – 48, line 59-61, Note: Even though Item 38 (ILR) on Fig 1, stores the authentication information of the Intranet users, it is connected to Item 54 (HLR) of Fig1). As per the Lemilainen, the first hybrid device

authentication is performed through the cellular communication (Col 3 line 20-30) and the information is stored in the HLR (Item 54 of Fig 1) database and shared with the ILR database for the users using the Intranet. Basically information wise ILR database stores a subset of the information stored in the HLR database).

4) As per claim 4 Lemilainen teaches that a method according to any of the claims 1, characterized in that said interface for short-range access at said hybrid wireless terminal (Item 12 of Fig 1) and at said service terminal (Item 26 of Fig 1) are compliant with the Bluetooth standard (Col 3 line 32 –37).

6) As per Claim 6 Lemilainen discloses that a service terminal (Item 26 of Fig 1) adapted to perform a transaction over a short-range wireless interface, (Item 12 of Fig 1 is a hybrid wireless terminal. It interacts with LAN (Item 32 of Fig 1) over the wireless interface.) comprising:

- means for receiving a user authentication information from a wireless terminal, said user authentication information being dedicated to authenticate a user in a radio communication network; (Col 5 line 19 – 21 and Col 3 line 32-37).
- an authentication module for authenticating said user at said service terminal by checking said received user authentication information against an authentication database of said radio communication network, said authentication module enabling said transaction if said authentication has

been successful. (Item 54 and 38 of Fig 1, Col 3 line 32-37 and Col 6 line 24-33)

7) As per Claim 7 Lemilainen discloses that a service terminal (Item 26 of Fig 1) according to claim 8 characterized in that further comprises decryption means for decrypting said received user authentication information according to a predefined decryption algorithm. (Col 8 line 35-40)

8) As per Claim 8 Lemilainen discloses, wireless terminal comprising a first part for communicating with a radio communication (Col 3 line 11-13) network and a second part for communicating with a service terminal (Item 26 of Fig 1) over a short-range wireless (Col 2 46-50) interface, said first part comprising a user authentication module for authenticating a user in said radio communication network (Col 3 line 11-19), said second part having access to said user authentication module and transmitting at least one user authentication information contained in said user authentication module over said short-range wireless access interface to said service terminal for authenticating said user in said service terminal (Col 3 line 32-37).

9) As per claim 9 Lemilainen discloses a wireless terminal according to claim 8, characterized in that it further performs encryption of said user authentication information according to a predefined encryption algorithm before transmitting said user authentication information over said short-range wireless interface (Col 3 line 66 to Col 4 line 13)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lemilainen (Patent# US 6766160 B1) in view of Ketcham (Patent# US 6075860).

5) As per claim 5 the applicant claims that a method according to claim 1, characterized in that said user authentication information is part of a Subscriber Identity Module card.

In the primary reference Lemilainen's shows a PIN code or user authentication information has been stored in the Hybrid terminal. Even though in Lemilainen's reference it has not been explicitly said that this authentication information is stored in SIM card, in the context of the secondary reference (Ketcham, Col 8 line 19-31), it has been mentioned that this authentication card is a portable storage device (e.g. smart card) and can be transported easily by the authorized users to a remote terminal. The common form of this authentication card is the Subscriber Identity Module (SIM) card and in case of GSM it is GSM Subscriber Identity Module (SIM) card. Therefore, it would have been obvious to a person with ordinary skill in the art to be motivated to store user authentication information in the Subscriber Identity Module (SIM) card.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashfaq Khan whose telephone number is (571) 272-7964. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ashfaq Khan
571-272-7964
November 22, 2004

Andrew Caldwell
Andrew Caldwell